

DOCKET NO.: CELG-0119
Application No.: 09/283,645
Office Action Dated: January 22, 2004

REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116

REMARKS

Claims 2-8, 10-13, and 15 are pending and stand rejected. Claim 15 has been amended, support for which may be found throughout the specification, for example, in Examples 1 and 2. Applicants also thank Examiner Chang for the opportunity to talk about the pending claims during a telephonic interview on March 15, 2004.

Claim 15 stands rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Jursic, *et al.*, *Tetrahedron: Asymmetry*, Vol. 5, No.9, p. 1712 (“the Jursic reference”). Claims 2-8, 10-13, and 15 stand rejected as allegedly being obvious under 35 U.S.C. 103(a) over the Jursic reference and in view of Berrang, *et al.*, CA 97:38738, Ohashi, *et al.*, CA 104:186157, Vanderplas, *et al.*, CA 118:101538, and Patrick, *Synthesis of Deuterium-Labelled Methylphenidate, p-Hydroxymethylphidate, Ritalinic Acid and p-Hydroxyritalinic Acid*, School of Medicine, University of North Carolina.

The Jursic reference does not anticipate the present invention because, among other things, it does not disclose the claimed step of physically isolating said acid salts. The Examiner noted in her answer to Appellant’s brief on page 8, that “[i]f appellants read the limitation of the examples from the specification into the claims so that it is limited to only solid salts separated from the reaction media, then Appellants must place such limitation in the claims.” In the Board’s decision, the Board noted that claim 1, now cancelled, failed to “recite the formation of acid salts or the step of isolating those acid salts as positive manipulative steps in the body of the claim.” The Board further noted that claim 1 was unlike claim 15 because of this. Applicants have amended claim 15 to define an embodiment where the preferentially formed acid salts are precipitated from the reaction media as

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suggested by the Examiner. Claim 15 positively recites the formation of acid salts as a manipulative step and is not anticipated by the Jursic reference.

The claims remain rejected for alleged obviousness over Jursic, in view of Berrang, Ohashi, Vanderplas, and Patrick. However, the Jursic reference teaches away from the present claims as the complexes allegedly disclosed by Jursic remain in solution and the present claims require precipitation. Therefore, there is no motivation for one skilled in the art to combine Jursic with the other cited references to obtain the present invention.

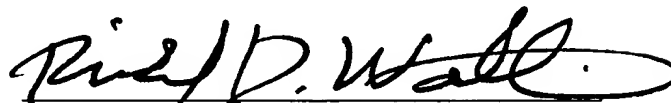
Applicants respectfully request that this rejection be withdrawn.

The claims also stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5,936,091.

This rejection is considered moot, as Applicants file herewith a terminal disclaimer.

Applicants believe that the forgoing constitutes a full response to the Office Action of record. Furthermore, it is respectfully submitted that this application is now in condition for allowance. Accordingly, an indication of allowability and a Notice of Allowance are respectfully requested.

Respectfully submitted,



Richard D. Watkins
Registration No. 50,993

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Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439